

REMARKS/ARGUMENTS

This is Applicants' response to the Office Action of August 17, 2007 in which claims 1-8 were allowed and claims 9-17 were rejected. In this response no substantive changes have been made to the claims with respect to the Third Preliminary Amendment filed September 26, 2005. The claims are presented in a manner that is believed to be consistent with the examples set forth in MPEP 1453. Applicants respectfully request reconsideration in view of the following remarks.

The notice of allowance of claims 1-8 set forth in the Office Action is appreciated.

Claims 9-172 apparently have been rejected on the basis that the reissue application for U.S. Patent 6,372,376 issued April 16, 2002, was filed on November 21, 2003, and the Declaration according to the Examiner did not state the reissue application is a broadening reissue. However, the Examiner has provided no authority for taking the position that a broadening reissue application is improper unless the Declaration explicitly states that the reissue application is a broadening reissue. Applicant respectfully requests the Examiner to provide support in 35 U.S.C., 37 CFR or judicial authority for the position. Otherwise, Applicant respectfully requests the Examiner to withdraw the objection on the basis that the Declaration does not explicitly state that the application is a broadening reissue.

Notwithstanding the above, the Examiner appropriately indicates that 35 U.S.C. 251 recites "no reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within 2 years from the grant of the original patent." Therefore, there is no

statutory basis requiring the Declaration to explicitly state that the application is a broadening reissue application, simply that an application must be filed which broadens the claims within 2 years of the grant of the original patent. The Examiner's attention is respectfully directed to the Declaration which indicates that the inventors had reviewed and understand the contents of the above-identified specification and the reissue application including claims as amended by the preliminary amendment. The first preliminary amendment amended claim 1 from reciting "a resistivity greater than about 50 ohm-cm" to "a resistivity no greater than about 50 ohm-cm". As such, the first preliminary amendment amended claim 1 to be broader so that amended claim 1 covers subject matter not covered by claim 1 as issued in U.S. Patent No. 6,372,376. As such, the inventors read and understood the contents of the specification and the amendments which amended claim 1 to be broader than claim 1 as issued in Patent No. 6,372,376.

Furthermore, the Examiner's attention is respectfully directed to the first page of the reissue application declaration by the inventors which indicates that they believe the original patent to be wholly or partially inoperative or invalid for reasons described below which included "by reason the patentee claiming more or less than he had a right to claim in the patent." This is a clear indication that the application is being filed on the basis that the original patent claimed less than the inventors had a right to claim and therefore the applicants were submitting claims which claimed more than the original patent. Furthermore, the form also included a section reciting:

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as the nature of the broadening:
The amendment to claim1 corrected an inadvertent error to claim 1. The word "no" should have been in the claim when the limitation of claim 12 were incorporated into claim 1 by

amendment (paragraph no. 4) dated June 25, 2001 during the prosecution of U.S. Patent No. 6,372,376.

As such, Applicant did indeed provide an explanation as to the nature of the broadening as being related to the insertion of the word “no” in claim 1.

The Examiner’s attention is also respectfully directed to MPEP 1412.03 IV which states:

A broadened claim can be presented within 2 years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented after 2 years from the grant of the original patent in a broadening reissue application which was filed within 2 years from the grant. Where any intent to broaden is indicated in a reissue application within 2 years from the patent grant, a broadened claim can subsequently be presented in the reissue after the 2 year period. Thus, a broadened claim may be presented in a reissue application after the 2 years, even though the broadened claim presented after the 2 years is different than the broadened claim presented within the 2 years. (underlining added)

Applicant maintains that the amendment to claim 1 in the first preliminary amendment was an indication of intent to broaden the reissue application within the 2 years from the patent grant, because amended claim 1 covers subject matter not covered by claim 1 or other claims in the issued patent.

Additional indication of intent to broaden is found in the explanation provided in the reissue application declaration that the amendment to claim 1 was being entered to correct the error in claim 1 by the inclusion of the word “no” before greater in claim 1.

It appears also that the broadening reissue application is being rejected on the basis that “it appears that patent claim 1 is more narrow than patent claim 8.” However, the Examiner’s

attention is respectfully directed to MPEP 1412.03 I, Meaning of “Broadened Reissue Claim” which states:

A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects.

A claim in a reissue which includes subject matter not covered by patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in a reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. Tilloitson, Ltd. v Walbro Corp., 831 F.2d 1033, 1037 n.2, 4 USPQ 2d 1450, 1453 n.2 (Fed. Cir. 1987); In re Ruth, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); In re Rogoff, 261 F. 2d, 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims does not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, the reissue patent application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for patent infringement of the product claims based upon the claims of the original patent. (underlining added)

Amended claim 1 is not more narrow than patent claim 8. In fact, amended claim 1 is broader in at least one respect than patent claim 8, even though it may be narrower in other respects, thereby meeting the meaning of a “broadening reissue claim.” The Examiner’s attention is respectfully directed to claim 8 which recites “said substrate comprising a first acid-soluble metal underlying a second acid-insoluble, passivating layer susceptible to oxidation in said environment.” Such language is not present in claim 1. As such, claim 1 is broader in at least one respect than claim 8. For example, claim 8 reads on the embodiment shown in FIG. 5, but not on

the embodiment shown in FIG. 4. However, claim 1 as amended, would read on both the embodiment of FIG. 4 and FIG. 5. Therefore, claim 1 is broader than claim 8.

Still further, if a party produced a fuel cell including the structure shown in FIG. 4 using a plurality of electrically conductive particles dispersed throughout an oxidation-resistant and acid-resistant, water-insoluble polymer matrix having a resistivity no greater than ohm-cm, neither of claim 1 or claim 8 of the issued patent 6,372,376 would read on such a device. However, amended claim 1 would indeed read on the embodiment shown in FIG. 4 and therefore claim 1 is a broadening reissue claim and applicant is entitled to submit subsequent broadening reissue claims as set forth in claims 9-172 after 2 years from the date of the patent grant.

The application was also objected to on the basis that it appears to the Examiner that Howard N. Conkey is not a party authorized to sign the consent of assignee because there is nothing in the record to show that he is a party who is authorized to act on behalf of the assignee. Applicant has attached hereto a document dated 20 October 1992 signed by the Assistant Secretary of General Motors Corporation authorizing Howard N. Conkey to act as an agent of General Motors for the purpose of executing on behalf of General Motors documents in proceedings before the United States Patent and Trademark Office. Withdrawal of the objection is respectfully requested.

Applicant has also submitted a new Consent of Assignee signed by Timothy G. Gorbatoff, Assistant Secretary of General Motors Corporation, and a Declaration of Mr. Gorbatoff, verifying that General Motors Corporation did indeed consent to the reissue application by way of the reissue application: Consent of Assignee form signed by Howard N Conkey on November 21, 2003. Withdrawal of the objection under 37 CFR 1.172(a) is respectfully requested.

Applicants note that the Examiner has not made a finding that the inclusion of the word "no" immediately prior to "greater than 50 ohm-cm" did not broaden claim 1 to cover subject matter not covered by the limitation "having a resistivity greater than about 50 ohm-cm". Although claim 1 might be narrower in some respects, any amendment which broadens any aspect of claim 1 results in a broadened claim 1.

In view of the above remarks, Applicant respectfully requests reconsideration and notice of allowance of all the claims now in the case.

Respectfully submitted,

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